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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MCCAMEY, ANN M	
		ART UNIT	PAPER NUMBER	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12192003

Application Number: 10/049,294

Filing Date: February 11, 2002

Appellant(s): HASEGAWA, MANABU

Christopher D. Ward
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed November 3, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 10 and 11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

GB 2326050 A KUBO 9-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubo (GB 2 326 050 A).

Regarding claim 10, Kubo discloses a card attachment and detachment device holding detachably a card in a space defined between a body and a bottom plate, comprising:

a holder 52 for being inserted into and removed from the space and having a card accommodation section accommodating the card;
a lock member 52c for holding the holder within the space;

a release member (distal end of 52c) for releasing the lock of the lock means;

and

a biasing member 52c-2a (Fig. 7E) for ejecting the holder when the card is removed from the card accommodation section.

The limitation, "for ejecting the holder when the card is removed from the card accommodation section," is a recitation of intended use, and has only been given patentable weight to the extent that the prior art structure must be capable of performing this function to meet the limitation. In this case, biasing member 52c-2a, as seen in Fig. 7E, is capable of aiding in the ejecting the holder, since the slanted shape of the feature will force the holder to eject, e.g. when a user releases the lock member in the position seen in Fig. 7E. Therefore, this limitation is anticipated by Kubo.

Regarding claim 11, Kubo discloses a rib 52a-1 positioned at a part of the card accommodation section, the rib coming into contact with a distinctive shaped section of the card when the card is placed in the card accommodation section.

(11) Response to Argument

Applicant's arguments are directed to whether Kubo discloses, "a biasing member for ejecting the holder." Applicant sets forth three arguments:

(i) Kubo does not teach a biasing member for ejecting a holder. Instead, Kubo describes the card holder (52) as being removed from the housing (51) by *using the forefinger of an operator to engage handle (52c-3)*" (emphasis added). In response to Appellant's argument, there is nothing in the claim language that precludes the use of

an operator to aid in the ejecting of the holder. Furthermore, Appellant's invention also requires the use of an operator to press release member 37 to actuate the ejection mechanism.

(ii) "Kubo teaches a structure in which the engagement craw (52c-2) is not even in contact with the frame portion (51a-41) during removal of the card holder from the housing (51), and therefore no portion of the engagement craw (52c-2) could be said to eject the holder (52)." In response, the Examiner agrees that Kubo does not explicitly disclose the slant portion being *for ejecting the holder*. However, this deficiency is not such that it necessitates an obviousness-type rejection, since only "a biasing member" is being positively recited. "For ejecting the holder" is a recitation of intended use that has not been given patentable weight of its own. It has only been given weight to the extent that a prior art structure needs to be capable of performing the intended use to meet the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). "Capable of" is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In this case, the engagement craw 52c-2 is capable of performing this function, since if the operator were to release the lock member at the position shown in Fig. 7E, the slanted surface would bias the holder in the ejection direction.

(iii) "[T]he upward force of the engagement craw (52c-2) on the frame portion (51a-41) would need to be of sufficient magnitude to overcome the various frictional forces present between the holder and the housing...which is unlikely." Applicant here

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is conceding a possibility (although "unlikely") that the engagement crav would be able to, with sufficient force, aid in ejection of the holder. Applicant argues that the force relied on is a Z direction force. The Examiner disagrees. During ejection, an operator moves the holder in the ejection direction (Y-direction). The slant portion extends in a Y-Z direction. The addition of these two forces necessarily results in slant portion acting as "a biasing member," aiding in ejecting of the holder.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ann McCamey
December 20, 2003

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